

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.
2. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
 3. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.
 4. Group I, claim(s) 1-17 and 27-32, drawn to a method for coating articles.
 5. Group II, claim(s) 18-25 and 33-35, drawn to a coated article.
 6. Group III, claim(s) 26, 36, and 37, drawn to a coating composition.
7. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The corresponding technical feature between Group I and II is a metal surface article having a polysiloxane coating thereon. This is not a special corresponding technical feature because this subject matter is anticipated or rendered obvious by Volker et al. EP 1127930. Volker et al. teaches coating surfaces with organosilane compositions that cure to form polyorganosiloxane coatings. See Volker et al. (paragraphs 1-20; and Claim 1). Volker et al. does not exemplify using metal articles, but teaches and claims that metal articles can be effectively coated in this manner. In the event that this disclosure would not be considered to be an anticipatory teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention and would not have constituted an inventive step to apply the coating compositions of Volker to metal articles since Volker suggests that Volker's compositions may be effectively applied to metal articles to form coatings thereon. The corresponding technical feature between Group I and III or between Group II and III is an organosilane coating composition, which is not a special corresponding special technical feature because the corresponding subject matter is anticipated by Volker EP 1127930 and by Iwato et al. WO 01/90267. Volker teaches coating compositions comprised of mixtures of organosilane materials. See Volker (paragraphs 1-20; and Claim 1). Iwato et al. teaches a coating composition comprising a mixture of fluoroalkyl-silane and alkoxyalkylalkane. See Iwato et al. (page 6, line 30 through page 7, line 9).

Neither Claim 1 nor claim 18 requires the particulars of the organosilane composition claimed in Claim 26.

8. Due to the complexity of the restriction requirement, a telephone call was not made to request an oral election to the above restriction requirement.
9. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.
10. The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.
11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
12. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention

must require all the limitations of an allowable product claim for that process invention to be rejoined.

13. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b).

Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

CONCLUSION

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL LAVILLA whose telephone number is

(571)272-1539. The examiner can normally be reached on Monday through Friday.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil, can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Michael La Villa/
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11 January 2010**